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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,033	12/11/2000	Masaaki Nishino	040447/0227	2515

22428 7590 06/17/2004

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

HO, TUAN V

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 06/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,033

Applicant(s)

NISHINO ET AL.

Examiner

TUAN HO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,11,14,16,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,6,8-10,13,15,17,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 4,7 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2, 4, 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election of the species of Fig. 2a and 2b, claims 3-5, 6-10, 12, 13, 15, 17 and 20-21 in the reply filed on 5/28/04 is acknowledged. Claims 1-2, 11, 14, 16, 18 and 19 are withdrawn from further consideration on the merits. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claim 21 is objected to because of the following informalities: the term "to to", line 2 should be changed to "to". Appropriate correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenichi (JP 10-313452) cited by Applicants.

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With regard to claim 3, Kenichi discloses in Fig. 7, a portable radio communication apparatus that comprises the camera unit (camera 5, paragraphs [0035] and [0036] of the translation), shutter button (touch sensor button 7b or 7c, [0027]), view finder (view finder 16, [0035]), housing for the camera and view finder (member 1A is a housing for camera 5 and view finder 16; where the housing is used to protect the camera and finder 16), pair of flat cases (members 1A or 1B pivots through hinge 2 as shown in Fig. 6), display unit (member 1B comprises display 7, [0027]), and hinge (hinge 2 connects members 1A and 1B, [0034]).

With regard to claim 5, Kenichi discloses in Fig. 7, a portable radio communication apparatus that comprises the viewfinder is retractable into the housing (viewfinder 16 is retracted into a storing crevice 15 with member 1A as shown in Fig. 7, [0035]).

5. Claims 13, 17, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Umezawa et al (US 5,491,507).

With regard to claim 13, Umezawa et al discloses in Fig. 13, an video telephone apparatus that comprises the camera unit (camera unit 61, col. 15, line 15), housing for

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the camera (camera 61 is housed by hinge mechanism 51 as shown in Fig. 13), pair of flat cases (first unit 49 and second unit 50, col. 15, line 14), hinge (hinge 51a and 51b, col. 15, line 13), each of the cases equipped with a display (display 11 is in first unit and display 14 is in second unit 50, col. 15, line 33 and col. 16, line 23), hinge equipped within the housing (hinges 51a and 51b), optical axis of lens of the camera (optical axis of optical lens of camera 61 is perpendicular to the axis of hinge mechanism as shown in Fig. 13), and case units (first unit 41 and second unit 50 can be folded so that the units face outside as shown in Fig. 14).

With regard to claim 17, Umezawa et al discloses the display units (Fig. 14 and Fig. 13 show the units that are opposite and the same side).

With regard to claim 20, Umezawa et al discloses in Fig. 13, the camera unit (camera 61), two display units (displays 11 and 14), and one of which used for viewing an image taken in by the camera (display 11).

With regard to claim 21, Umezawa et al discloses in Fig. 13, the other display unit is opposite to the one of the two units and used to visually recognized from a

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subject side (when the subject is a user, the display 11 is used to display the user subject).

6. Claims 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Isashi (US 5,898,600).

With regard to claims 6 and 10, Isashi discloses a portable information processing apparatus that comprises the camera unit (photographing unit 7a, col. 15, line 36), shutter button (keyboard 4a includes one predetermined key served as shutter release button, col. 16, lines 32-41), terminal operation button (keys of keyboard 4a is used to operate the laptop computer 1a), and terminal operation button acts as the shutter button (one predetermined key of keyboard 4a is used as shutter button when the personal computer is switching to a photographic mode, col. 16, lines 42-50).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isashi.

With regard to claim 8, Isashi discloses the same subject matter as discussed with respect to claim 6, except that the terminal operation button is a scroll button related to the display unit.

Isashi does not explicitly disclose any terminal button that is a scroll button related to the display unit. However, keyboard of Isashi inherently includes a scroll arrow key to scroll a cursor or text up and down or.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the scroll key of Isashi as a shutter button key for camera 7a when the computer is in a photographic mode because the scroll key having two different modes makes the operation more easily without changing other key of the keyboard and there by to improve the versatility of the Isashi apparatus.

With regard to claim 9, Isashi discloses the scroll key that has vertically pressing function corresponding to a shutter button as discussed in claim 8.

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8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Umezawa et al.

With regard to claim 15, Umezawa et al disclose the same subject matter as discussed with respect to claim 13, except that one of the display unit faces a subject and displays a mirror image of an image as taken in by the camera.

Umezawa does not explicitly disclose any mirror image displayed when a user takes an image of himself. However, mirror images are displayed when a user takes an image of himself such as a news reporter. The reason for displaying a mirror images is to make a user to easily to recognize his motions in front of the camera and thereby to record an image more naturally to a viewer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the camera of Umezawa et al so as to display a mirror image of a user when the display 11 faces a user.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject

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matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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11. Claims 4, 7 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Park discloses an folded compact image capture apparatus.

Mack, II et al discloses a convertible portable telephone.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (703) 305-4943. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WENDY GARBER, can be reached on (703) 305-4924. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed

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to the receptionist whose telephone number is (703) 305-4700.



TUAN HO

Primary Examiner

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